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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,049

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Johan Lier

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EXAMINER

YEAGLEY, DANIEL S

ART UNIT

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3611

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,049	<b>Applicant(s)</b> LIER ET AL.	
	<b>Examiner</b> Daniel Yeagley	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24,28-32 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24,28-32 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/16/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 4, 5 and 8 are objected to because of the following informalities:
    - a. Regarding claim 4 and claim 5, lines 3, both occurrences of the word “orundetachably” should be changed to --or undetachably--.
    - b. Regarding claim 8, line 5, the phrase “to *the* outside” lacks proper antecedent basis and should either be change to read as:

--to *an* outside-- or more preferably stated as:  
--to extend outside the third wall of the transverse beam--
- Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1 – 24, 28 – 32 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. Regarding claims 1, 17, 28 and 31, the words “it” are considered indefinite.
  - b. Regarding claims 1, 4, 5, 12, 17 and 31, the phrases “such as” are considered indefinite.
  - c. Regarding claims 8 and 9, the words “preferably” are considered indefinite.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 – 6, 11 and 16 – 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickmann 4,678,199.

Dickmann shows an assembly of a vehicle and a coupling assembly for the vehicle, wherein the vehicle comprises a chassis having a transverse beam 47 situated at the rear side of the vehicle (figure 8, column 9, line 9-10 and column 10, line 13-14), the transverse beam is tubular having a first wall (upper wall of 47) and an opposite second wall (respective lower wall of 47) and is polygonal in cross-section with a third wall connecting the first and second wall, and wherein the coupling assembly comprises a second coupling member 2 permanently or undetachably attached to the transverse beam, and is placed in the transverse beam and attached to the first and second walls of the transverse beam by means of welding (column 8, line 67-68), and wherein the coupling assembly includes a first coupling member 7 provided with a connection member 6, such that the second coupling member is coupled to the first coupling member to connect the first coupling member to the vehicle, wherein the second coupling member comprises an accommodation member (opening in bottom of element 2), in which an insertion member upper portion of element 7) can be coupled in the accommodation member.

Art Unit: 3611

6. Claims 1 – 6, 11 and 16 – 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Biedenbach et al DE3233813.

Biedenbach shows an assembly of a vehicle and a coupling assembly for the vehicle, wherein the vehicle comprises a chassis having a transverse beam situated at the rear side of a vehicle (figure 1), which shows the transverse beam being tubular having a first wall (upper wall of beam) and an opposite second wall (respective lower wall of beam) and is polygonal in cross-section with a third wall connecting the first and second wall, wherein the third wall is provided with an opening *for* access to element 6 and wherein the coupling assembly comprises a second coupling member 2 permanently or undetachably attached to the transverse beam, and is placed in the transverse beam and attached to the first and second walls of the transverse beam by means of welding; as clearly shown in figure 1, and wherein the coupling assembly includes a first coupling member 3 provided with a connection member, such that the second coupling member is coupled to the first coupling member to connect the first coupling member to a vehicle, wherein the second coupling member comprises an accommodation member (opening in bottom of element 2), in which an insertion member (upper portion of element 7) can be coupled in the accommodation member.

7. Claims 1, 2, 7, 9 – 11, 16 – 24, 28 – 32 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Seksaria et al 6,464,240.

Seksaria discloses a chassis for a vehicle that is provided with a coupling assembly comprising a second coupling member (tow hitch 30) that is permanently fixed and undetachably connected to the chassis for detachable coupling to a further coupling member (not shown; a

Art Unit: 3611

first coupling member provided with a connection member for a car trailer or an accessory), wherein the second coupling member comprises an accommodation member 32, in which an insertion member (common hitch tongue of the first coupling member which is not shown), and is commonly coupled in the accommodation member for an accessory to be taken along by the vehicle by towing or carrying (figure 1), wherein the chassis comprises a transverse beam 10 situated at the rear, the coupling member 30 being fixedly attached to the transverse beam by welding (figure 4, column 3, line 40-45), by means of a placement flange 38 and 52 for abutment to the outside of the transverse beam, such that the flange is at least almost circumferential and forming a unity therewith (the transverse beam), wherein the transverse beam is tubular and polygonal in cross-section and the coupling member; as best shown in figure 1, extending into the transverse beam by extended wrapping of the coupling member to at least two of the sides of the polygon, wherein the coupling member is provided with an eye and one or more means 58 for attaching a safety cable and for a hauling or towing cable, wherein the eye and/or the means for attaching a safety cable forming a unity with the second coupling member.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dickmann '199.

Art Unit: 3611

Dickmann discloses a second coupling member that is inherently made of metal, since hitch assemblies are commonly made of metal, such as steel and is obtained by some known forming process, but was silent with regards to the material and failed to disclose the forming method used to produce the second coupling member, such as an injection molding process.

Dickmann discloses the claimed invention except for the process. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have obtained the second coupling member from a forming process, such as injection molding, since the examiner takes Official Notice of the equivalence of forming parts from a method of casting and injection molding for their use in the process method art and the selection of any of these known equivalents to produce the coupling member; such as by a metal injection molding process would have been within the level of ordinary skill in the art and further the method of forming the device itself is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

10. Claims 12 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickmann '199, in view of Hebeisen 2,978,260.

Dickmann disclosed a first coupling member that has a first part 7 coupled to a second coupling member 2 and includes a second part that can be connected to an operation member 6, but failed to show the first and second parts of the first coupling member being dividable, with the second part defining an accommodation sleeve for accommodation of an insertion member of the operation member.

Hebeisen shows a coupling assembly having a first coupling member (figure 4 or 7) that includes a first part 13 coupled to a second coupling member 10, which shows the prior art of dividing the first coupling member into two parts as claimed, wherein the second part (stud shaft of operation member 12) which is dividable from the first part; as claimed and is such that the second part defines an accommodation sleeve (stud shaft) for accommodation of an insertion member (ball) of the operation member, but failed to show the division of parts being a plate-shaped part coupled by bolts through holes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the first coupling member of Dickmann coupling assembly with a simple dividable coupling member, such as suggested by Hebeisen dividable coupling member, in order to provide the first coupling member of Dickmann with a simple dividing means for allowing the coupling member the ability to remove one part from the first part to further provide easy inter-changing of the coupling ball with alternative size coupling balls to accommodate trailers of various size hitch sockets; and is very well known in the art, as is the art of providing the coupling member of a hitch with a plate-shaped means for alternatively bolting the parts together as an alternative means for attachment of the operation member to the accommodation sleeve which is also well known in the art.

11. Claims 7, 8, 10, 12 – 14, 23, 24, 28 – 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biedenbach et al '813, in view of Hebeisen '260, in further view of St. Pierre et al 4,948,311.



Biedenbach disclosed an assembly with a coupling assembly comprising a tow hitch, that includes a first and second coupling member, wherein the second coupling member is welded to upper and lower walls of a transverse beam; as stated above, wherein the first and second walls are connected by a rearward third wall that included an opening *for* access to an element 6 that extends at least partially through the rearward opening of the beam to the outside; as broadly claimed, but failed to show the second coupling member having an eye, where the eye extends at least partially through the opening of the third wall.

Hebeisen shows a coupling assembly, wherein the first coupling member is divideable into first and second parts; as stated above, and further shows a second coupling member coupled to a transverse beam, the second coupling member 10 of Hebeisen shows the prior art of providing a threaded component 30 (eye component) that extends from the rearward side of the second coupling to the outside; as broadly claimed, and wherein the extending eye component of Hebeisen is provided for allowing the possibility of attaching thereto other elements (column 2), and wherein the extended eye component is capable of extending at least partially through an opening of a rearward component; such as a wall member of a transverse beam; if desired, and is further capable of supporting an eyelet member, but failed to show an eye on the extended component of the second coupling member.

St. Pierre, is cited as an example, of providing an extended eye component 28 that extends through an opening 84 in a wall member 50 with an eyelet 58 (figure 15) for providing a simple means for attachment of a hauling cable or safety cable (cargo securing line or the like; abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the coupling assembly of Biedenbach inserted second coupling member of the transverse beam assembly with a modified coupling member utilizing an extended eyelet extending from the second coupling member; as suggested by Hebeisen coupling member, in order to provided the assembly of Biedenbach with a means for allowing the possibility of attaching thereto other elements, as taught by Hebeisen and would further be obvious to one of ordinary skill to provide additional aid in supporting the second coupling member within Biedenbach transverse beam simply to provide additional support of the coupling member and would obviously further provide a means for holding the coupling member in place while welding the coupling member to the beam, and would have been further obvious to one of ordinary skill in the art to have secured the internal component with an eyelet; such as suggested by St. Pierre eyelet, in order to provide the extending component; as modified by Hebeisen, with a fastening means for secure the extending component to the wall and to further provide the extending eye component with additional utility; in order to allow for attaching thereto other elements as suggested by Hebeisen; such as a tie down fitting as taught by St. Pierre.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Braun et al '450 shows; in figure 2, the first and second coupling assembly members disposed in a transverse beam similar to applicants' invention.

Dickmann DE3004285 and EP169263, Hermbusch EP093795, Westerdale '295, Warner '514, Morris et al '179 and Hildreth et al '112 show first and second coupling members disposed in a transverse beam.

Krengel '098 shows a transverse polygonal beam with an opening in the third wall having an eye extending out from the opening.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Yeagley whose telephone number is (571)272-6655. The examiner can normally be reached on Mon. - Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on (571) - 272 - 6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

D.Y.

**/Lesley D. Morris/  
Supervisory Patent Examiner, Art Unit 3611**